

Application No. 10/651,205  
Response Dated December 8, 2004  
Reply to Office Action of October 8, 2004

**REMARKS/ARGUMENTS:**

Claims 1 – 30 are currently pending in the application, with claims 1, 8, 23, 26 and 29 being independent. Claims 1 – 16, 18 – 21, 29 and 30 have been rejected, while claims 17 and 22 are objected to and claims 23 – 28 are allowed. No new matter has been added to the claims.

Applicants have carefully considered the contents of the Office Action and respectfully request reconsideration and reexamination of the subject application in view of the explanations noted below.

**Rejections under 35 U.S.C. § 102**

Claims 1, 3, 5 and 7 are rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,967,990 to Rinderer (the “Rinderer patent”). Applicant respectfully traverses this rejection, since the Rinderer patent clearly does not disclose, teach or render obvious the subject matter of rejected claims 1, 3, 5 and 7.

The Rinderer patent discloses a brace assembly for supporting an outlet box. The assembly includes a brace 21 having a base and mounting surfaces 51 that extend from the base at an angle greater than 90 degrees. Flanges 53 extend from the mounting surfaces and have holes for receiving fasteners to secure the brace 21 to *upper faces* of the supports S.

The Rinderer patent does not show or disclose a mounting surface having an angle greater than 90 degrees with the base to create a compression fit between the mounting surface and a support member during installation, as claimed in amended independent claim 1. As discussed in paragraph [0041] of Applicants’ specification, the angle between the mounting surfaces and their respective support member creates a compression fit during installation between the brace member and the support members. This compression fit secures the brace assembly between the support members and allows an installer to release the brace assembly without the brace assembly falling, thereby freeing the hands of the installer to provide a more easily and efficiently installable brace assembly.

As is clearly shown in FIG. 2 of the Rinderer patent, the mounting surfaces of the elongate extensions 51 do not contact the supports S and do not create a compression fit with the supports. There is no disclosure or suggestion in the Rinderer patent to create a compression fit between the brace assembly and the supports S during installation. As cited

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in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single, prior art reference”.

Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, since there is no disclosure or suggestion of a compression fit or of a mounting surface contacting a support member when installed, independent claim 1 is not anticipated by the Rinderer ‘990 patent.

Furthermore, independent claims 1, 8, 17 and 29 recite functional language directed to creating a compression fit upon installation of the brace assembly. In the action, no weight is given to this functional language in the claims. This is improper. As stated in MPEP § 2173.05(g), “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used”. MPEP § 2173.05(g) goes on to further state that “[a] functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step”. The Rinderer patent does not disclose the problem identified in Applicants’ specification regarding the awkwardness of holding a brace assembly with one hand while attempting to insert fasteners with the other hand to secure the brace assembly to the support during installation. Nor does the Rinderer patent disclose the solution of creating a compression fit between the brace assembly and the support members to free the hands of the installer by having mounting surfaces at an angle greater than 90 degrees adapted to create the compression fit, thereby overcoming the above-identified problem. The Rinderer ‘990 patent does not address this problem because, as shown in FIG. 2, the Rinderer brace assembly 1 is adapted to be installed to upper surfaces of the supports S. Therefore, the above problem is not present when using the Rinderer ‘990 brace assembly, and, thus, there is no disclosure or suggestion in the Rinderer ‘990 patent of creating a compression fit between the brace assembly and the supports.

Therefore, the Rinderer ‘990 patent does not disclose nor render obvious the features of Applicants’ invention recited in amended independent claim 1. Since the Rinderer patent does not disclose, teach, or suggest all of the limitations of independent claim 1, Applicants submit that claim 1 is allowable.

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Claims 3, 5 and 7, being dependent upon independent claim 1, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as the first mounting surface having a first fastener hole to receive a first fastener to secure the brace member to the first support member of claim 3; a first flange extending perpendicularly outwardly from the first mounting surface and being adapted to be received on a lower surface of the first support member of claim 5; and a second mounting surface extending from a second end of the brace member and forming an angle greater than 90 degrees with the base of claim 7. Therefore, dependent claims 3, 5 and 7 are not anticipated or rendered obvious by the cited patent, particularly within the overall claimed combination.

**Rejections under 35 U.S.C. § 103(a)**

Claims 2, 4, 6, 8 – 16, 18 – 21, 29 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Rinderer patent alone or the Rinderer patent in view of at least one of the following U.S. Patent Nos. 4,050,603 to Harris et al. (the “Harris patent”); or 5,040,316 to Fast (the “Fast patent”). Applicants respectfully traverse this rejection, since the Rinderer patent alone or in view of at least one of the Harris or Fast patents clearly does not disclose, teach or render obvious the subject matter of rejected claims 2, 4, 6, 8 – 16, 18 – 21, 29 and 30.

The Rinderer patent does not disclose a brace assembly having mounting surfaces at an angle greater than 90 degrees that are adapted to create a compression fit with a support member, as recited in independent claims 1, 8 and 29. The Harris patent is merely cited for disclosing prongs in the mounting surfaces, as shown in FIG. 1. The Fast patent is merely cited for disclosing score lines in the mounting surfaces to adjust the length of the brace assembly.

The deficiencies in the Rinderer patent noted above with respect to independent claim 1, which features are also recited in independent claims 8 and 29, are not cured by the Harris or Fast patents. The Harris and Fast patents do not disclose or render obvious a brace assembly having a mounting surface at an angle greater than 90 degrees adapted to create a compression fit with a support member, as recited in independent claims 1, 8 and 29.

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Thus, claims 1, 8 and 29 are allowable for the above discussed reasons.

Claims 2 – 7 and 9 – 22 and 30, being dependent upon independent claims 1, 8 and 29, respectively, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents. For example, the fastener holes in the mounting surfaces of claims 3, 9 and 10; the prongs extending outwardly from the mounting surfaces of claims 4, 11 and 12; flanges extending outwardly and adapted to be received on a lower surface of the support member of claims 5, 13 and 14; and the mounting surfaces extending from the base at an angle of approximately 94 degrees of claims 2, 15 and 16, are not anticipated or rendered obvious by the cited patents, particularly within the overall claimed combination.

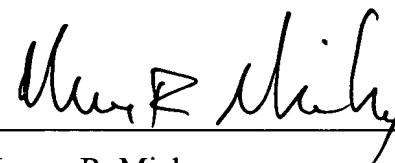
**Allowable Subject Matter**

Applicants appreciate the indication of allowed subject matter regarding claims 23 – 28. Applicants also appreciate the indicated allowability of claims 17 and 22, which are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

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In view of the foregoing explanations and comments, Applicants respectfully submit that claims 1 – 30 are allowable over the cited patents. Prompt and favorable action is solicited.

Respectfully Submitted,



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